

REMARKS

Applicants have carefully considered the August 28, 2008 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-8 were pending in this application. Claim 8 has been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

In response to the Office Action dated August 28, 2008, new claim 9 has been added and the specification at Table 1 has been amended to correct an obvious typographical error. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Izumida et al. (U.S. Pat. App. Pub. No. 2004/0099354, hereinafter “Izumida”). Applicants traverse.

Claims 1-7 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 6 of Izumida. Applicants note that U.S. Pat. App. Pub. No. 2004/0099354 is now issued as U.S. Pat. No. 7,404,865. Applicants traverse.

One of the characteristics of the stainless steel wire of the present application, as represented by claim 1, is that it has a texture in which the diffraction intensities of the austenite phase by X-ray diffraction in the longitudinal direction of the steel wire satisfy both  $I(200)/I(111) \geq 2.0$  and  $I(220)/I(111) \geq 3.0$ .

As disclosed in paragraph [0024] of the present application as published, this characteristic is achieved by controlling the condition of the drawing, more specifically, by performing a hard drawing with a total reduction in area above 60% and particularly 70% or more. See paragraph [0051] and Table 3, etc. The last sentence of the paragraph [0024] reads that the texture satisfying the above specified orientation can not be provided if the total reduction in area is 60% or less. New dependent claim 9 has been added to further recite this feature.

Turning to the Izumida reference, it is noted that Izumida also performs drawing and the working degree (reduction of area) is desirably controlled at 50% to 70%, more desirably at 55% to 65% (paragraph [0029]). In fact, reduction of area is at 60% in the embodiments (paragraph [0053]). With such degrees, a desired texture satisfying the above specified orientation as required in claim 1 can not be obtained.

In other words, the steel wire of Izumida is produced by a completely different production method and it does not have a texture satisfying the specified orientation of the present claimed subject matter. Each and every limitation must be disclosed or suggested by the cited prior art references in order to establish a *prima facie* case of obviousness (*see*, M.P.E.P. § 2143.03) and for at least the foregoing reasons the Examiner's applied reference fails to do so, it is respectfully submitted that the rejection is not legally viable for at least this reason and should be withdrawn for at least the foregoing reasons.

Further, if any independent claim is non-obvious under 35 U.S.C. § 103(a), then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Regarding Double Patenting

In response, Applicants note that a double patenting rejection of the obviousness-type is nearly analogous to the nonobviousness requirement of 35 U.S.C. § 103. See *In re Braithwaite*, 379 F.2d 594, 154 U.S.P.Q. 29 (CCPA 1967). Moreover, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. § 103 obviousness determination. See *In re Braat*, 937 F.2d 589, 19 U.S.P.Q.2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 U.S.P.Q. 645 (Fed. Cir. 1985). The factual inquiries outlined in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. § 103, should be employed when making an obvious-type double patenting analysis. Therefore, Applicants respectfully traverse the obvious-type double patenting rejection for substantially the same reasons set forth above in response to the 35 U.S.C. § 103(a) rejection. As already discussed, the steel wire of Izumida is produced by a method that is completely different from the present claimed subject matter and the reference does not have a texture which satisfies the above specified orientation. Accordingly, Izumida fails to disclose or suggest a steel wire having a texture which satisfies the present claimed orientation.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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